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## RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte NEWTON B. WHITE, JR.

Appeal 2007-2251  
Application 09/381,742  
Technology Center 3600

## Oral Hearing Held: December 19, 2007

22Before HUBERT LORIN, ANTON W. FETTING, JOSEPH A.

23FISCHETTI, Administrative Patent Judges

24  
25ON BEHALF OF THE APPELLANT:

CARL OPPEDAHL, ESQUIRE (via videoconference)  
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33The above-entitled matter came on for hearing on Wednesday, December  
3419, 2007, commencing at 9:58 a.m., at the U.S. Patent and Trademark  
35Office, 600 Dulany Street, Alexandria, Virginia, before Beverly J. Mahoney,  
36Notary Public.

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2  
PROCEEDINGS

3 JUDGE LORIN: Counsel, we are in session now. We see you  
4clearly. This is Appeal Number 2007-2251. You have 20 minutes. When  
5you're ready, you may proceed.

6 MR. OPPEDAHL: Good morning. I will reserve five minutes for  
7rebuttal after the examiner. Is the examiner present?

8 JUDGE LORIN: No, the examiner is not present.

9 MR. OPPEDAHL: Then I will proceed. I invite questions from the  
10board, of course, as we proceed. We have 16 issues to cover and 20 minutes  
11to cover our 16 issues. I prefer to focus on any particular issues that Your  
12Honors may find most deserving of the time.

13 First, I will just give a moment's comment to the first issue on appeal.  
14The first issue on appeal is directly to claim 196. And this is -- I will  
15suggest that this is essentially a signal claim, a claim that recites a sequence  
16of ones and zeros.

17 Of course, what we would urge to the board is that, just like any signal  
18claim that has the possibility of being patentable subject matter, the chief  
19questions then would be whether it's novel and unobvious.

20 And we suggest that since the examiner has not raised issues of  
21novelty or unobviousness, that so far as the first issue on appeal is  
22concerned, we suggest that reversal of the rejection be in order.

23 JUDGE LORIN: Counsel, you are aware of the recent case in the  
24Federal Circuit decision in Nuitjen, which held that signal claims are not  
25patentable subject matter. Would you like to speak to that?

26 MR. OPPEDAHL: That case was not cited by the examiner, Your

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1Honor.

2        JUDGE LORIN: Are you then suggesting that we should reverse  
3without addressing that case?

4        MR. OPPEDAHL: No. I'm just suggesting that if the case had been  
5cited by the examiner, we would have been in a position both to address it in  
6our reply and would have been in a position to comment on whatever the  
7examiner said characterizing the case.

8        JUDGE LORIN: So what is your view? How should we proceed  
9with this claim with that case available to us?

10        MR. OPPEDAHL: Well, it's a tough situation. This appeal was fully  
11briefed more than three years ago. And had the case been decided -- had the  
12appeal been decided at all, within even a few months of when it was fully  
13briefed, it could have been decided based on the law the way it was at the  
14time it was briefed.

15        I guess the board has no choice but to decide the case based on things  
16that happened after this was fully -- in the three years that have passed since  
17this case was fully briefed.

18        Well, if I may, let me press on to some of the other issues on appeal.  
19We have several issues on appeal that relate to a cited reference, Adams.

20        And in several instances we have claims that are rejected under  
21Section 102 as being supposedly anticipated by Adams. The --

22        JUDGE LORIN: Counsel, can I stop you for a second. You seem to  
23be moving on to issues of prior art. But I notice that there are also pending  
24issues under 101 with respect to a number of your claims. Would you  
25address that first, please.

26        MR. OPPEDAHL: Yes, Your Honor.

1        The patentable subject matter, Section 101 rejections, for example, the  
2second issue on appeal, of course, the chief thing that has happened since the  
3case was fully briefed is more recent opinions that say that it is not necessary  
4to have technological arts in the claim for it to be patentable subject matter,  
5and that really the chief requirement is that there be concrete tangible result.

6        At the risk of oversimplifying, the changes in the law relating to  
7Section 101 that have occurred since these briefs were filed are changes that  
8affect the case only in the direction of furthering our appeal, make it more  
9favorable to the appellant.

10       So we have -- in the briefs we discuss at some length the concrete and  
11tangible results that can be found in the claims. In many cases the examiner  
12did not raise a question of whether a concrete or tangible result was present  
13in the claim.

14       Indeed, for most of these claims the examiner only raised  
15technological arts issues. So given those changes in the law, my suggestion  
16would be that, as to the patentable subject matter issue on appeal, that that  
17should be reversed.

18       JUDGE FETTING: Do you have a view as to whether Comiskey, the  
19recent opinion from the Federal Circuit, which stated that a claim that's  
20wholly drawn to mental steps, whether that case applies to, for instance,  
21claim 169?

22       MR. OPPEDAHL: It is not the case that these claims are mental steps  
23claims. For example, claim 169 there is a sending of a reply. A sending of a  
24reply is not simply a mental step. A sending of a reply is more than  
25somebody just thinking, Oh, yes, I have received a request, or I have  
26received something.

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1       Indeed, receiving a request is also more than a mental step. It  
2 involves receiving a communication from elsewhere. There is very little in  
3 claim 169 that could be characterized as mere mental steps.

4       The same can be said about many of the other claims. Claim 170,  
5 which has some 30 limitations, has implicit in it that there is the limitations  
6 of the independent claim from which it depends, in which there is sending of  
7 a reply.

8       In the appellant's brief we analyze one by one particular items of  
9 concrete and tangible result that can be found in each of the claims that were  
10 rejected relating to subject matter.

11       In each case we have listed, for example, receiving of information,  
12 sending a reply, publishing information and so on. So in each case there are  
13 limitations presented. They are more than mere mental steps.

14       JUDGE FETTING: For example, in claim 169, could the receiving  
15 and sending encompass oral communications?

16       MR. OPPEDAHL: This is, of course, a method claim with steps in it.  
17 And of course, under the last sentence of Section 112 the steps are construed  
18 as those steps set forth in the specification, together with the equivalence  
19 thereof.

20       The only steps set forth are embodiments that involve communicating  
21 messages between different entities, typically one of which is a computer, or  
22 a system, physical system.

23       So you have a situation where the -- you know, the only embodiments  
24 set forth for those method steps are essentially performed with computers  
25 and other physical systems.

26       JUDGE FETTING: Did I gather that you are contending that claim

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1169 is being construed under 112, sixth paragraph?

2       MR. OPPEDAHL: That the method steps -- well, I suppose the best  
3way to put this is it's -- the best way to put this is that the claim is construed  
4with respect to what is in the specification.

5       And what is in the specification is only computer and other steps  
6carried out by physical apparatus. Nowhere in the specification do we have  
7human beings speaking things to each other, that that is somehow how these  
8steps are carried out. That's just nowhere in the specification.

9       So regardless of whether the Patent Office were to take the position  
10that these are step plus function elements, or whether the Patent Office or the  
11Federal Circuit were not to take the position that step plus function -- in  
12either case there is this perspective of the specification, in which the only  
13recited ways of doing this are with computer and physical systems.

14      JUDGE FETTING: You may proceed.

15      MR. OPPEDAHL: Just looking at the clock.

16      If I may, with our limited time, move forward to the rejections, the  
17fifth issue on appeal and the other issues on appeal that relate to the Section  
18102 rejections with respect to the reference Adams.

19      The appellant's brief goes on in some length detailing particular  
20limitations in the rejected claims that we simply cannot find in Adams.

21      We can't find in Adams by sitting and reading it, as people would  
22normally read it. If we bring up the full text of Adams and just do text  
23searches, there are whole words that we simply can't find in Adams.

24      When the rejection came in, back before the case was on appeal, we  
25cited the case of In Re Alhert and Kruger, asking the examiner to please  
26state the basis for the view that certain limitations could be found in Adams.

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1And the examiner never did that.

2 So we went to appeal with situations where there was literally no  
3showing where certain of those limitations could be found in Adams.

4 When we filed our appeal brief we then detailed elements, limitations  
5in the claims, that we couldn't find in Adams. And we, of course, were in a  
6position when we received the examiner's brief to read the examiner's brief  
7to see if the examiner had addressed those missing limitations. And we  
8couldn't find it in the examiner's brief.

9 So I suggest to the board that there is a quite clear record that the  
10Section 102 anticipation rejections of claims over Adams, each one of them,  
11we suggest, fails because of at least one limitation that the examiner never  
12did show to be found anywhere in Adams.

13 So those are my comments about Section 102, rejections over Adams.  
14There are a few issues on appeal: 11th, for example, and 12th, where the  
15rejection is an obviousness rejection, a Section 103 rejection over Adams.

16 There we have, first, some missing elements, which would not  
17necessarily be fatal to a rejection. But in addition to missing elements, as we  
18detail in the appellant's brief, there are several places in, for example, the  
1911th and 12th issues on appeal, several places where we urge that Adams  
20actively teaches away from what is said in our claim.

21 So it is our suggestion that it's not merely that there are missing  
22elements, missing limitations, but also that Adams couldn't render those  
23claims, those obviousness rejected claims, that Adams could not render  
24those claims unpatentable because it teaches away from what is in those  
25claims.

26 In particular, teaching away from publishing in the ordinary plain

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1English sense of making some information available to the general public.

2        So there are my comments, our comments, with respect to the 103

3rejections with Adams, and Adams when combined with the second

4reference.

5        I would like to just take a moment to review my notes to see how to  
6allocate the remaining time. It should just take a moment.

7                    (Pause in the proceedings.)

8        MR. OPPEDAHL: The next issue that I would like to address for the  
9board is the third issue on appeal. The third issue on appeal has to do with --  
10to give an example, claim 177.

11        Claim 177 is a method claim. The method claim includes, for  
12example, a digital signature. And then in addition to there being a digital  
13signature, the method calls for using a separate means of securing  
14communication, other than the digital signature.

15        By way of background or perspective, of course, what we're looking  
16at is a situation where in many cases digital signatures are used in part to  
17provide assurance to a recipient that the message really came from whoever  
18it purports to have come from, if the digital signature represented a signature  
19by the sender, for example.

20        Here in the claim we are talking about securing the message in a  
21separate manner, in a separate manner distinct from that of the digital  
22signature.

23        What we have in the office actions, and what we have in the  
24examiner's brief, is a ground for rejection that I find difficult to know how to  
25respond to in plain language, or in plain English.

26        The examiner essentially says, Once you have a digital signature, I

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1can't think of any reason why you would also secure the message in some  
2other way.

3        It strikes me that those words from the examiner are essentially an  
4admission of unobviousness. That if what is recited in the claim is  
5something that the examiner can't imagine anybody would ever think to do, I  
6take that as the very indication of unobviousness. That the examiner's  
7inability to see why somebody would do that ought not to be grounds for  
8rejection.

9        And yet it's the very situation, as far as I can tell, that we face in the  
10wording of the rejection, both as set forth in the Office actions and as recited  
11in the examiner's brief.

12        Turning to the fourth issue on appeal, we have 112 rejections where  
13the examiner -- well, without much detail or explanation, the examiner  
14rejects about nine claims. And in each case computer apparatus are  
15explicitly set forth in the claims.

16        Claim 169, for example, claim 169 explicitly says that a computer  
17apparatus is included. That language, the language in parentheses, Which  
18system includes without limitation a computer apparatus, is language that  
19got added during prosecution because the examiner kept saying that the  
20examiner wanted to see "computer apparatus" in the claim.

21        So the applicant did finally put in amendments saying that, yes, the  
22system includes a computer apparatus. And what we have is the examiner  
23saying that that's indefinite somehow, that because we said there could be  
24something else in addition to a computer apparatus, that that makes it  
25indefinite.

26        I have been drafting claims for many years, and I am used to the idea

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1that when we draft a claim and the claim says that the apparatus contains an  
2A, a B and a C, that, of course, the apparatus could also contain a D, E or an  
3F, and that this shouldn't surprise anyone that that might be the case, that the  
4apparatus might contain more things than what is listed in the claim.

5        And yet that's the very ground for rejection that gave rise to the fourth  
6issue on appeal, this limitation that says that there is computer apparatus and  
7there could be something else.

8        JUDGE LORIN: Counsel, have you seen this before in your  
9experience, this parenthetical information in a claim?

10        MR. OPPEDAHL: It's not a question of whether we saw it or not.  
11We were in a telephone interview with the examiner, who said that that  
12would overcome a particular concern.

13        So we put it in based on a telephone review. It's frustrating to us to  
14find out that later the examiner didn't like the very thing that the examiner  
15had suggested be added.

16        JUDGE LORIN: You are saying the examiner suggested that you put  
17this parenthetical information in the claim?

18        MR. OPPEDAHL: Yes.

19        JUDGE LORIN: Which is what you did?

20        MR. OPPEDAHL: Yes.

21        JUDGE LORIN: It's hard to tell because, you know, when you see  
22something parenthetical, you get the impression that it's -- you know, it may  
23be included and, you know, it may not be included. It's hard to say.

24        MR. OPPEDAHL: Well, I respectfully suggest otherwise. Looking  
25at claim 169, for example, Which system includes without limitation a  
26computer apparatus.

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1 I take that to be quite clear, quite definite. It is putting forth that the  
2system includes a computer apparatus. I don't see anything fuzzy or  
3questionable about that.

4 I can't see anything about those words or that punctuation to  
5question whether the system does or does not include a computer apparatus.

6 JUDGE FETTING: Maybe I'm reading a little weird. But to me the  
7phrase "without limitation" reads out potentially the computer apparatus.  
8You are saying "includes without limitation." So doesn't "without  
9limitation" suggest the possibility of not including it?

10 MR. OPPEDAHL: No. No. "Without limitation" means other things  
11could be included as well. It could be a computer apparatus plus a ping-  
12pong ball. It could be a computer apparatus plus a paper clip. "Includes  
13without limitation," meaning, yes, computer apparatus, but we're not limiting  
14it to a computer apparatus.

15 There could also be a power plug or a battery or something else.

16 JUDGE FISCHETTI: Counsel, haven't you already stated that as a  
17practitioner you understood that these claim construction automatically and  
18inherently understands that A, B and C are mandated, but you can still have  
19a D, F and G?

20 So my question is, why bother with the "without limitation" if that  
21understanding is already prevalent in your drafting technique?

22 MR. OPPEDAHL: This came from a telephone conversation,  
23telephone conference, with the examiner. And unfortunately, I did what the  
24examiner said in the phone call and, you know, that's the way it is. We  
25could amend this, we could change it to say, Which includes a computer  
26apparatus; it may include other things, but that's not helpful.

1        It's not helpful to say "may include," because that sounds like  
2something is optional. We all know that we can't be putting optional things  
3in the claims.

4        JUDGE LORIN: Well, your position is that -- what you are trying to  
5say here is that this method for operating the system includes at least a  
6computer?

7        MR. OPPEDAHL: Includes at least a computer apparatus, yes. It  
8would be like a chair with at least three legs. And yes, sometimes chairs  
9have four legs. If I say "at least three legs," I don't see that that makes it  
10indefinite. That the possibility of a fourth or fifth leg being on the chair, I  
11don't see how that introduces any more indefiniteness at all.

12        This case has had a long and tortured examination. And, you know,  
13this is the second appeal already in this case. And there are a lot of things  
14about the claims that are not the way they were drafted in the first place,  
15because of things that the examiner said and the objections that the examiner  
16raised.

17        I wouldn't have chosen that. I did not choose that language when the  
18case was first drafted. When I drafted these claims nine years ago, I didn't  
19have those words in there.

20        Drawing upon my experience, I didn't put in those words, but they got  
21there because of the prosecution.

22        I see that I have used up my time. I welcome the opportunity to  
23answer any further questions Your Honors may have. Otherwise, I will  
24thank you for your time.

25        JUDGE LORIN: No, Counsel, it looks like we have no further  
26questions. Thank you. And we will take your comments under advisement.

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1 MR. OPPEDAHL: Thank you. Good day.

2 JUDGE LORIN: Good day.

3 (Whereupon, the proceedings at 10:20 a.m. were concluded.)